

REMARKS

Claims 1-27 are pending and claims 18-27 have been withdrawn from consideration following Applicants' provisional election, with traverse, to prosecute the invention of Group I, claims 1-17, which are drawn to an article. As requested by the Examiner, Applicants hereby affirm this election of Group I, claims 1-17.

Claims 1, 2 and 3 have been amended with this Action. These Amendments were made to facilitate prosecution of the application, and not in acquiescence to the rejections of record. Applicants respectfully reserve the right to pursue the original claims in a continuing application(s). No new matter has been added with these amendments. Support for the amendment for claim 1 can be found throughout the application as filed, for example, at page 3, lines 16-20, and page 8, line 16 through page 9, line 7. Support for the amendment to claim 2 can be found throughout the application as filed, for example, at page 13, lines 17-18. Support for the amendment to claim 3 can be found throughout the application as filed, for example, at page 4, lines 11-16.

Applicants' detailed response to the rejections recited in the Office Action follow.

Objection to the Specification

The Office Action states that disclosure is objected to because of an informality. In particular, the Office Action states that page 10, line 18-20 should recite "[t]he fabric can be up to about 95% open, *i.e.*, 5% of surface area of the article is porous fabric, and is typically at least about 90% open," and not "[t]he fabric can be up to about 95% open, *i.e.*, 5% of surface area of the article is porous fabric, and is typically at least about 50% open" (emphasis added).

Contrary to the statement in the Office Action that the specification should refer to a porous fabric that is "about 90% open", Applicants respectfully aver that the specification, as filed, referring to a porous fabric that is "typically at least about 50% open," correctly reflects the scope of certain embodiments of the invention. Accordingly, reconsideration and withdrawal of the objection to the specification is respectfully requested.

Rejection under 35 U.S.C. §112, 2nd

The Office Action states that claim 3 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Office Action states that “it is unclear as to what the applicant means by ‘said second surface covers no more than 50% of the article surface area.’”

In response, Applicants have amended claim 3 to recite “wherein said adhesive-carrying porous fabric covers no more than 50% of the article surface area.” This amendment clarifies that the “second surface” referred to in original claim 3 refers to the surface area (*i.e.*, non-open area) of the adhesive-carrying porous fabric, which the “second surface” is a part of. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

Rejection under 35 U.S.C. §102

The Office Action states that claim 2 is rejected under 35 U.S.C. §102(b) as being anticipated by Schneler *et al.* (U.S. Patent No. 2,740,403).

In Response, Applicants have amended claim 2 to specifically require that the “adhesive penetrates into about 25% to about 75% of the porous backing.” As described throughout the application as filed, the amended claim reflects an important embodiment of the invention that, in part, ensures the proper porosity of the overall resulting article. Significantly, this range of “about 25% to about 75%” penetration into the porous backing is not taught by the Schneler *et al.* patent. Nowhere does Schneler *et al.* provide guidance to this elemental aspect of the invention reflected in amended claim 2.

It is well-established law that, in order to anticipate a claim, a reference must teach each and every element of that claim. In the instant case, the Schneler *et al.* patent does not teach the required range of “about 25% to about 75%” penetration into the porous backing, as reflected in amended claim 2. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Rejections under 35 U.S.C. §103

The Office Action states that claims 1 and 3 have been rejected under 35 U.S.C. §103(a). In particular, claim 1 has been rejected under 35 U.S.C. §103(a) as being unpatentable over the Schneler *et al.* patent in view of Murphy *et al.* (U.S. Patent No. 5,762,623), and claim 3 has been rejected under 35 U.S.C. §103(a) as being unpatentable over the Schneler *et al.* patent alone. Applicants respectfully traverse these rejections for the reasons that follow.

First, as to claim 1, Applicants respectfully assert that there would be no motivation to combine the teachings of Murphy *et al.* relating to the use of a warp-knitted (weft insertion) fabric layer, which would impart hand tear properties on an a laminated article into which it is incorporated, with the teachings of Schneler *et al.*, which purports to teach an adhesive bandage with “breathing pores”. Furthermore, even if such motivation was present, the skilled artisan would have no reasonable expectation of success in making the combination.

In particular, Applicants note that the Murphy *et al.* patent does not teach a porous article in general, or the manner of obtaining porosity in an assembled article, in particular. Furthermore, the Murphy *et al.* patent teaches a laminated tape in which a warp-knitted (weft insertion) fabric is bonded together to a second layer which is elastic. An important aspect of achieving hand tear in a tape is to ensure that the individual fibers or yarns of the warp-knitted (weft insertion) fabric are held in place and prevented from sliding, and/or “bunching up”, when a transverse “tearing” force is applied to the tape. If the individual fibers or yarns are allowed to “bunch up” in such a manner, then the force required to break through their collective strength is greater than that which can be readily generated by an average human hand. Accordingly, the proper bonding of these individual fibers or yarns to an anchoring second layer is important to achieve hand-tear.

Significantly, the instant invention is drawn to a porous article, in which the backing substrate, corresponding to the second “anchoring” layer, is left open or porous. Since an open or porous backing cannot provide continuous contact with a warp-knit (weft-insertion) fabric layer, there would be no motivation to combine the hand-tear related teachings of Murphy *et al.* with the porous layer teachings of Schneler *et al.* to arrive at the instant invention. Furthermore, even if the skilled artisan did combine these teachings, there would be no reasonable expectation

of success in so doing since the instant invention provides an open porous backing which, the skilled artisan would appreciate, would not be expected to provide enough anchoring to the warp-knit (weft insertion) fabric layer to prevent “bunching up” of the fibers or yarns. Accordingly, the skilled artisan would not expect the combination of Murphy *et al.* with Schneler *et al.* to result in an article with the claimed hand-tear-imparting features. This same argument hold true for rejected dependent claims 4-17 as well.

Finally, with regard to claim 1, Applicants note that they have amended claim 1 to particularly point out that the “adhesive of the adhesive-carrying fabric (is) located on the fabric in such a manner that the fabric remains more porous than the backing substrate” (emphasis added). Neither Schneler *et al.* nor Murphy *et al.* teach or suggest this important element of the claimed invention. Accordingly, the combined teachings of Schneler *et al.* nor Murphy *et al.* do not render claim 1 obvious under 35 U.S.C. § 103(a).

Furthermore as to claim 3, the Office States that “although Schneler *et al.* does not specifically teach the first surface and the second surface of fabric as claimed...it is obvious that the carrier of Schneler *et al.* has a first surface and a second surface (*i.e.* two surfaces).” While the inherency of two surfaces in a carrier fabric is not here disputed, Applicants respectfully point out that, as amended and further explained above, claim 3 requires that the “adhesive-carrying porous fabric covers no more than 50% of the article surface area.” It is this aspect of the claimed invention that is not taught by the Schneler *et al.* patent. In particular, the Schneler *et al.* patent fails to teach any percent open area for achieving a porous tape. Since this important element of the invention, which applicants have discovered is an important aspect of achieving porosity in embodiments of their invention, is not taught by Schneler *et al.*, this reference alone cannot render the claimed invention obvious under 35 U.S.C. §103(a) since it fails to teach each and every element of the claimed invention. This same argument hold true for rejected dependent claims 4-17 as well.

Accordingly reconsideration and withdrawal of the rejection of claims 1 and 3, as well as claims 4-17, under 35 U.S.C. §103(a) is respectfully requested.

CONCLUSION

In view of the amendments to the claims and the arguments presented above, Applicants respectfully aver that the claims are in good condition for allowance, and reconsideration of the rejections and notification of such allowance is hereby respectfully requested.

Applicants hereby request that the period for responding to the outstanding Office Action mailed July 28, 2005, be extended for three months' time, up to and including January 30, 2006, to maintain the pendency of the above-identified case. The Commissioner is hereby authorized to charge the required fee of \$510 for filing the request for extension of time to our Deposit Account No. 08-0219. Please charge any additional fees or credit any overpayments to Deposit Account No. 08-0219.

If the Examiner believes that a telephone conference would expedite this matter, the Examiner is respectfully requested to telephone the applicant's undersigned attorney at (617) 526-6045.

Dated: January 30, 2006

Respectfully submitted,

By 

James T. Olesen

Registration No.: 46, 967

WILMER CUTLER PICKERING HALE AND
DORR LLP

60 State Street

Boston, Massachusetts 02109

(617) 526-6000

Attorney for Applicant